

REMARKS

Claims 1, 3 – 19, 21, and 23 – 40 have been examined. Claims 1, 3, 4, 8 – 10, 13, 14, 16 – 18, 23 – 27, 31, 32, 34 – 37, 39, and 40 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pat. Publ. No. 2002/0016740 (“Ogasawara”) in view of U.S. Pat. Publ. No. 2005/0040230 (“Swartz”); Claims 5 – 7, 11, 12, 15, and 28 stand rejected under 35 U.S.C. §103(a) as unpatentable over Ogasawara in view of Swartz and further in view of U.S. Pat. Publ. No. 2003/0018522 (“Denimarck”); Claims 19, 21, 33, and 38 stand rejected under 35 U.S.C. §103(a) as unpatentable over Ogasawara in view of Swartz and further in view of U.S. Pat. Publ. No. 2002/0015176 (“Takao”); Claims 29 and 30 stand rejected under 35 U.S.C. §103(a) as unpatentable over Ogasawara in view of Swartz and further in view of Denimarck and Takao. The rejections are respectfully traversed.

First, all of the rejections rely on disclosures of Swartz that are not prior art to the application. Specifically, the application has a filing date of August 30, 2001 (Exhibit 1, Filing Receipt). Swartz has a filing date of October 4, 2004 and claims the benefit of various earlier filing dates according to an application chain that identifies five applications going back as far as September 5, 1996. The relevant filing date for establishing that certain disclosures of Swartz are prior art is whether any particular one of these “prior application(s) properly supports the subject matter used to make the rejection.” MPEP 706.02(f)(1).

In this instance, the Office Action cites ¶¶ 79, 115, and 191 as providing disclosures relevant to the rejections. But the earliest inclusion of these disclosures in the application chain is in U.S. Pat. Appl. No. 09/990,597, filed November 21, 2001. A copy of the immediately preceding application, U.S. Pat. Appl. No. 09/487,923, filed January 19, 2000, was obtained by Applicants from the Office’s PAIR site and is attached as Exhibit 2. An examination of this application clearly shows that the disclosures relied on in the Office Action are absent so that those disclosures are only entitled to a filing date as early as November 21, 2001, i.e. *later* than the filing date of the Application.

If the Office maintains any rejection over Swartz, Applicants request a specific identification of support for an earlier claimed filing date given that Swartz itself only has a filing date later than the filing date of the Application.

Second, even if the disclosures of Swartz were prior art to the Application, Applicants respectfully disagree that any of the cited art discloses the limitation of independent Claim 1 of “for each customer who does not execute a transaction with the first entity, recording particulars of such each customer’s visit in the database as part of a record affiliated with an identification of such each customer,” or the corresponding limitations of independent Claims 29, 31, and 36. The Office Action appears to acknowledge at p. 4 that such a limitation is not disclosed in Ogasawara, citing ¶¶ 79, 115, and 191 for this limitation.

Notwithstanding the assertion in the Office Action, none of these portions of Swartz discloses the claim limitation, particularly the requirement that the particulars be recorded as part of a record affiliated with an identification of such each customer. For example, ¶79 describes generally the type of information that may be recorded when a customer *does* execute a transaction, but is silent about recording information for customers “who do[] not execute a transaction.” Similarly, ¶115, while disclosing that a video camera may be used “to record customer transactions,” is silent on recording particulars of a visit by a customer “who does not execute a transaction.” Even if it may be inferred from the disclosure of ¶115 that visits by customers who do not execute transactions will also be recorded by the video camera, there is no teaching or suggesting of affiliating a record that includes particulars of each customer’s visit with an identification of that customer. Finally, ¶191 describes generally the presentation of messages to customers who execute transactions about specific products; it does not teach or suggest recording information about customers who do not execute a transaction, and certainly does not teach or suggest affiliating a record that includes particulars of such a customer’s visit with an identification of the customer.

Since at least this limitation of each of the independent claims is not taught or suggested by the cited art, no *prima facie* case has been established under §103(a). MPEP 2143.

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PATENT

The independent claims are accordingly believed to be patentable and the claims that depend therefrom are believed to be patentable by virtue of their dependence from patentable claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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